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EXAMINER	
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ART UNIT	PAPER NUMBER
1637	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/536,502	GEDDES ET AL.	
	Examiner	Art Unit	
	Angela M. Bertagna	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-10,12-16,18-22 and 24-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-10,12-16,18-22 and 24-27* is/are rejected.

7)☒ Claim(s) *1,4,6,8,9 and 15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/11/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

1. Applicant's response filed on May 5, 2009 is acknowledged. Claims 1, 4-10, 12-16, 18-22, and 24-27 are currently pending. In the response, Applicant amended claims 1, 4, 9, 15, 16, and 19. Claim 23 was canceled.

The following include new grounds of rejection necessitated by Applicant's amendments to the claims. Any previously made objections or rejections not reiterated below have been withdrawn as being obviated by the amendment. Applicant's arguments filed on May 5, 2009 that remain relevant to the new grounds of rejection below have been fully considered, but they were not persuasive for the reasons set forth in the "Response to Arguments" section. Accordingly, this Office Action is made **FINAL**.

Information Disclosure Statement

2. Applicant's submission of an Information Disclosure Statement on February 11, 2009 is acknowledged. A signed copy is enclosed.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not appear to provide proper antecedent basis for the use of a detection device comprising a luminometer microscope or flow cytometer (see claims 7 and 22). Also, the specification does not appear to provide proper antecedent basis for

the use of a detection device comprising any combination of a spectrometer, luminometer microscope, plate reader, fluorescent scanner, or flow cytometer (claims 7 and 22).

Claim Objections

4. Claim 1 is objected to because of the following informalities: The words "*B. anthracis*" in line 1 of the claim should be replaced with "*Bacillus anthracis*", since this is the first use of the term in the claims. Also, replacing the word "which" in line 6 with "that", deleting the word "and" in line 7, and replacing the word "thereby" in line 18 with "and" is suggested to improve the grammar of the claim.

Claim 4 is objected to because of the following informalities: Deleting the words "nucleotide sequence of" in line 4 is suggested to improve the grammar of the claim and maintain consistency with claim 1.

Claim 6 is objected to because of the following informalities: This claim appears to contain a typographical error where "emission" is recited. It would appear that "emissions" was intended.

Claim 8 is objected to because of the following informalities: Replacing the term "the immobilized metalized particles" with "the immobilized metal particles" is suggested to improve consistency with claim 1.

Claim 9 is objected to because of the following informalities: Deleting the word "complementary" in line 2, replacing the word "probe" in line 2 with "probes", and replacing the words "high stringent" with "highly stringent" is suggested to improve the grammar of the claim.

Claim 15 is objected to because of the following informalities: Inserting the word "the" before the words "immobilized metal particles" in line 3 is suggested to improve the grammar of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4-10, 12-16, 18-22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (WO 97/27317 A1; cited previously) in view of Gryczynski et al. (Photonics Spectra (October 2001) 35(10): 96, 97, 99-102, 104; cited previously) and further in view of Cao et al. (Journal of the American Chemical Society (July 2001) 123: 7961-7962;

cited previously) and further in view of Qi *et al.* (Applied and Environmental Microbiology (2001) 67(8): 3720-3727; cited previously).

These claims are drawn to a method for detecting *Bacillus anthracis* in a sample. The method comprises hybridizing a sample suspected of containing *Bacillus anthracis* nucleic acids to an oligonucleotide immobilized on a layer of immobilized metal particles followed by hybridizing a fluorescently labeled oligonucleotide to the hybridized duplex.

Lockhart teaches methods of detecting target nucleic acids via array hybridization (see abstract and page 3, line 5 - page 6, line 12).

Regarding claims 1 and 16, the method of Lockhart comprises:

(a) providing surface-immobilized capture nucleotide sequence probe complementary to a first portion of a target nucleic acid (see page 71, lines 1-14; see also Figures 12 and 13)

(b) contacting a sample and the capture nucleotide sequence probe, thereby binding any target nucleic acids that are complementary to the capture nucleotide sequence probe (page 71, lines 1-14 and Figures 12-13)

(c) contacting any bound target nucleic acids with a free nucleotide sequence probe, wherein the free nucleotide sequence probe has an affinity for a second portion of the target nucleic acid and has a fluorophore attached thereto (see page 71, lines 21-28, page 72, lines 23-31, and Figures 12-13; pages 36-39 teach that the label may be a fluorophore)

(d) identifying the target nucleic acid by fluorescence emission resulting from excitation of the fluorophore following irradiation (see page 73, lines 9-14 and pages 69-70).

Regarding claims 6, 7, 21, and 22, Lockhart teaches detecting fluorescence emission with a device comprising a fluorescent scanner (pages 69-70).

Regarding claim 8, Lockhart teaches covalent immobilization of the capture nucleotide sequence probe to the surface (page 8, lines 20-23).

Regarding claim 9, Lockhart teaches binding the capture and free nucleotide sequence probes to the target nucleic acid under highly stringent hybridization conditions (pages 66-67).

Regarding claims 12, 14, 25, and 27, Lockhart teaches the use of a fluorophore having a low quantum yield, specifically rose bengal (see page 38, line 21).

Regarding claims 13 and 26, Lockhart teaches the use of fluorophores that can undergo two-photon excitation (see page 37, line 2, where fluorescein and rhodamine are taught).

Lockhart does not teach that the immobilized capture probes are attached to metal particles or a metal layer on a substrate as required by claims 1 and 16, respectively. Also, Lockhart does not teach that the free nucleotide sequence probe further comprises a metal colloid attached thereto for sandwiching the fluorophore between the metal colloid and the metalized substrate as required by claims 15 and 16. Lockhart also does not teach detection of *Bacillus anthracis* as required by claims 1 and 18.

Gryczynski teaches a method for increasing the fluorescence of a fluorophore using metal particles (page 96).

Regarding claims 1, 15, and 16, Gryczynski teaches that "Silver particles can have several beneficial effects on fluorophore brightness, suggesting improvements in applications such as DNA analysis (Figure 2)." Gryczynski teaches that the beneficial effects include increased photostability, decreased lifetime, increased quantum yield, and improved detectability (see Figure 2, page 96, column 1, and Table 1). Gryczynski also teaches that the intrinsic fluorescence from DNA and the extrinsic fluorescence from a fluorophore bound to DNA can be

enhanced by sandwiching the fluorophore between metal particles (see Figures 5, 7, & 8 and pages 101-102).

Regarding claims 4 and 19, Gryczynski teaches that the distance between the fluorophore and the metal particle should be between about 50 and about 200 Angstroms (see page 99, column 2). This range overlaps with the claimed range of about 50 Angstroms to about 500 Angstroms. Gryczynski further states, "There will be a zone near the surface where the effects are maximal (page 99, column 2)."

Regarding claims 5 and 20, Gryczynski teaches the use of silver particles (see Figures 2-5, 7 and 8, for example).

Regarding claims 6, 7, 21, and 22, Gryczynski teaches detecting fluorescence emission using a detection device comprising a spectrometer (page 97 and Figure 3, for example).

Regarding claims 10 and 24, Gryczynski teaches irradiating the fluorophore using a single photon or a two-photon excitation means (pages 99, 102, and 103 and Table 1).

Regarding claims 12-14 and 25-27, Gryczynski teaches using a fluorophore with a low quantum yield, such as Rhodamine B or rose bengal (see Figure 3 and page 100).

Gryczynski does not teach immobilization of nucleic acids onto the metal particles as required by claims 1, 8 and 16. Gryczynski also does not teach detection of *Bacillus anthracis* nucleic acids.

Cao teaches a method for synthesizing oligonucleotides modified with silver particles covalently bound to the 5' or 3' terminus (page 7961 and Figure 2). Cao teaches that these oligonucleotides may be used in nucleic acid hybridization assays (see page 7962 and Figure 2).

Cao does not teach detection of *Bacillus anthracis* nucleic acids.

Qi teaches a method for detecting *Bacillus anthracis* in a sample using PCR. Regarding this pathogen, Qi states, "*Bacillus anthracis* is a causal agent of anthrax, a serious and often fatal infection of livestock and humans. It is considered one of the most effective biological weapons of mass destruction because of its highly pathogenic nature and spore-forming capability and has attracted attention due to its potential use as a biological warfare agent (page 3720, column 1)."

It would have been *prima facie* obvious for one of ordinary skill in the art at the time of invention to apply the teachings of Gryczynski to the method of Lockhart. Specifically, an ordinary artisan would have been motivated to immobilize the capture oligonucleotides on a layer of immobilized metal particles positioned on the surface of the array and additionally attach a metal colloid to the fluorophore-containing detection probe so as to sandwich the fluorophore between two metal layers, since Gryczynski taught that such sandwiching of low quantum yield fluorophores, such as rose bengal, results in increased photostability, decreased lifetime, increased quantum yield, and improved detectability (see above). An ordinary artisan would have had a reasonable expectation of success in covalently attaching the capture and detection probes of Lockhart to metal colloids, since Cao taught methods of covalently attaching silver particles to oligonucleotides (page 7961). Finally, regarding the ranges set forth in claims 4 and 19, as noted in MPEP 2144.05, "In the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a *prima facie* case of obviousness exists." *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

An ordinary artisan also would have been motivated to apply the method resulting from the combined teachings of Lockhart, Gryczynski, and Cao to the detection of any clinically

relevant nucleic acid, such as nucleic acids from the pathogenic microorganism, *Bacillus anthracis*, which Qi taught is "one of the most effective biological weapons of mass destruction (page 3720, column 1)." An ordinary artisan would have had a reasonable expectation of success in designing capture and free nucleotide sequence probes to detect *Bacillus anthracis*, since Qi taught that the complete *Bacillus anthracis rpoB* gene sequence was publicly available and successfully designed nucleic acid primers and probes from this sequence (see pages 3722-3724). Thus, the methods of claims 1, 4-10, 12-16, 18-22, and 24-27 are *prima facie* obvious in view of the combined teachings of Lockhart, Gryczynski, Cao, and Qi.

7. Claims 1, 4-10, 12-16, 18-22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cao *et al.* (Science (2002) 297: 1536-1540; cited previously) as evidenced by Malicka *et al.* (Biopolymers (2003) 72(2): 96-104; cited previously) and Lukomska *et al.* (Biochemical and Biophysical Research Communications (2005) 328: 78-84; cited previously) in view of Lakowicz (US 2002/0160400 A1; cited previously and hereafter "Lakowicz I") and further in view of Lakowicz *et al.* (Biochemical and Biophysical Research Communications (2001) 286: 875-879; cited previously and hereafter "Lakowicz II").

These claims are drawn to a method for detecting *Bacillus anthracis* in a sample. The method comprises hybridizing a sample suspected of containing *Bacillus anthracis* nucleic acids to an oligonucleotide immobilized on a layer of immobilized metal particles followed by hybridizing a fluorescently labeled oligonucleotide to the hybridized duplex.

Cao teaches a sandwich assay for detecting target nucleic acid from a pathogen in a sample (see abstract and Scheme 1 on page 1537).

Regarding claims 1 and 16, the method of Cao comprises:

(a) providing surface-immobilized capture nucleotide sequence probe complementary to a first portion of a nucleotide sequence in the pathogen (see Scheme 1 and page 1537, column 1, paragraph 2)

(b) contacting the sample and the capture nucleotide sequence probe, thereby binding any pathogen nucleic acids that are complementary to the capture nucleotide sequence probe (see Scheme 1 and page 1537, column 1, paragraph 2)

(c) contacting any bound pathogen nucleic acids with a free nucleotide sequence probe, wherein the free nucleotide sequence probe has an affinity for a second portion of the pathogen nucleic acid and has a fluorophore attached thereto (see Scheme 1 and page 1537, column 1, paragraph 2)

(d) identifying the pathogen using surface enhanced Raman spectroscopy (see Scheme 1 and pages 1537-1538).

Further regarding claim 1 and also regarding claim 18, Cao teaches using the method to detect *Bacillus anthracis* (page 1538, column 1).

Regarding claim 8, Cao teaches covalent immobilization of the capture nucleotide sequence probe to the surface (see Scheme 1 and page 1537, column 1).

Regarding claim 9, Cao teaches binding the capture and free nucleotide sequence probes to the pathogen nucleic acid under highly stringent hybridization conditions (see page 1539).

Regarding claims 12 and 25, as evidenced by Malicka at page 100, column 1, the Cy3 fluorophore taught by Cao has a low quantum yield.

Regarding claims 13 and 26, as evidenced by Lukomska at pages 78-80, the Cy3 fluorophore taught by Cao can undergo two-photon excitation.

Cao does not teach that the immobilized capture probes are immobilized to metal particles or a metal layer on a substrate as required by claims 1 and 16, respectively. Also, Cao teaches detection using Raman spectroscopy rather than fluorescence spectroscopy. Finally, Cao does not teach that the free nucleotide sequence probe further comprises a metal colloid attached thereto for sandwiching the fluorophore between the metal colloid and the metallized substrate as required by claims 15 and 16.

Lakowicz I teaches a method for increasing the fluorescence of a fluorophore using metal particles (see abstract and paragraph 13).

Regarding claims 1, 15, and 16, Lakowicz I teaches that the fluorescence intensity of a fluorophore conjugated to a biomoleucle, such as DNA or RNA, can be increased at least 80 to 140 fold by positioning the fluorophore near a metal particle (paragraphs 13, 18, 71, and 84). Lakowicz I provides an example of this increase in fluorescence intensity in Figure 3, Figure 8, Figure 19, and paragraphs 114-116, 122, and 131-132, where the intensity of a fluorophore is increased by sandwiching between silver island films. Lakowicz I further teaches that may be substituted for the silver island films (paragraph 71).

Regarding claims 4 and 19, Lakowicz I teaches that the distance between the fluorophore and the metal particle should be optimized and separation distances between about 50 and about 2000 Angstroms, about 50 to about 200 Angstroms, and about 50 to about 300 Angstroms are particularly useful (paragraphs 71-72).

Regarding claims 5 and 20, Lakowicz I teaches the use of silver particles (paragraph 71) or gold particles (paragraph 70).

Regarding claims 6, 7, 21, and 22, Lakowicz I teaches detecting fluorescence emission using a detection device comprising a spectrometer (paragraph 76) or a fluorescent scanner (paragraph 91).

Regarding claim 8, Lakowicz I teaches covalent immobilization to the metal particles (paragraph 72).

Regarding claims 10 and 24, Lakowicz I teaches irradiating the fluorophore using a single photon (paragraph 149) or a two-photon excitation means (paragraphs 100 and 147).

Regarding claims 12-14 and 25-27, Lakowicz I teaches using a fluorophore with a low quantum yield, such as Rhodamine B, rose bengal, or fluorescein isothiocyanate (paragraphs 64, 66, and 84). Lakowicz I teaches fluorophores with a low quantum yield only fluoresce when they are adjacent to a metal particle (paragraph 105). Lakowicz I further teaches that these fluorophores can undergo two-photon excitation (paragraph 147).

Lakowicz II teaches that the intrinsic fluorescence from DNA and the extrinsic fluorescence from a fluorophore conjugated to a DNA molecule can be enhanced by sandwiching the fluorophore between metal particles (see abstract, page 875, and page 877, and Figure 3). Lakowicz further teaches that the fluorescence enhancement in the presence of metal particles is analogous to surface-enhanced Raman spectroscopy (page 878).

It would have been *prima facie* obvious for one of ordinary skill in the art at the time of invention to apply the teachings of Lakowicz I and Lakowicz II to the method of Cao. Specifically, an ordinary artisan would have been motivated to sandwich the Cy3 fluorophore

between metal particles, such as a metal colloid, and measure fluorescence emission from the fluorophore, as taught by Lakowicz I, since Lakowicz I and Lakowicz II taught that the fluorescence signal of a low quantum yield fluorophore could be enhanced by sandwiching the fluorophore between metal particles (see above). Since Lakowicz II taught that fluorescence enhancement by metal particles was analogous to surface-enhanced Raman spectroscopy (page 878) and since the methods of Lakowicz I and Lakowicz II were directed to enhancing the fluorescence of an extrinsic fluorophore conjugated to a nucleic acid (see above), an ordinary artisan would have been motivated to utilize either of these analogous detection methods to detect *Bacillus anthracis* in the method of Cao with a reasonable expectation of success. Thus, the methods of claims 1, 4-10, 12-16, 18-22, and 24-27 are *prima facie* obvious over Cao as evidenced by Malicka and Lukomska in view of Lakowicz I and further in view of Lakowicz II.

Response to Amendment

8. The declaration filed on May 5, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Cao reference (Science (August 2002) 297: 1536-1540).

Specifically, the evidence submitted on May 5, 2009 is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Cao reference. The evidence submitted on May 5, 2009 is also insufficient to establish diligence from a date prior to the date of reduction to practice of the Cao reference to either a constructive reduction to practice or an actual reduction to practice.

The evidence submitted on May 5, 2009 consists of a PowerPoint slide depicting the two assay methods (see Exhibit 1 and points 5-6 of the declaration) and a copy of the "Disclosure and

Record of Invention" indicating that a provisional patent application describing the methods depicted in the PowerPoint slides of Exhibit 1 was filed on November 26, 2002 (see Exhibit 2 and points 5-6 of the declaration).

This evidence is sufficient to establish conception of the claimed invention prior to the effective date of the Cao reference. The evidence is also sufficient to establish a constructive reduction to practice after the effective date of the Cao reference. However, the evidence submitted in the declaration filed on May 5, 2009 does not establish diligence from a date prior to the date of reduction to practice of the Cao reference to either a constructive reduction to practice or an actual reduction to practice.

Section 2138.06 of the MPEP provides guidance regarding the standard for assessing diligence. This section of the MPEP states that the critical period for assessing diligence begins "just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice." *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937). This section of the MPEP also states, "An applicant must account for the entire period during which diligence is required." *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). MPEP 2138.06 also cites *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949), which notes that Applicants must be specific as to dates and facts to establish diligence.

In this case, the evidence submitted on May 5, 2009 only contains a general allegation as to diligence during the critical period (*i.e.* the period between the just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice) and lacks a specific discussion of the activities conducted during the critical

period. This is not sufficient to establish diligence, since establishing diligence requires accounting for the entire critical period with specific dates and facts (see above).

Since the declaration filed under 37 CFR 1.131 is insufficient to overcome the Cao reference, the rejection of claims 1, 4-10, 12-16, 18-22, and 24-27 under 35 U.S.C. 103(a) as being unpatentable over Cao as evidenced by Malicka and Lukomska in view of Lakowicz I and further in view of Lakowicz II of has been maintained.

Response to Arguments

9. Applicant's arguments filed on May 5, 2009 remain pertinent to the new grounds of rejection presented above. These arguments have been fully considered, but they were not persuasive.

Regarding the rejection of claims 1, 4-10, 12-16, and 18-27 under 35 U.S.C. 103(a) as being unpatentable over Lockhart in view of Gryczynski and further in view of Cao and further in view of Qi, Applicant presents several arguments (see pages 6-12). In view of the cancellation of claim 23, this rejection currently applies to claims 1, 4-10, 12-16, 18-22, and 24-27.

Applicant first argues that the combined teachings of the cited references do not result in all of the claimed limitations. In particular, Applicant argues that Lockhart does not teach probes that are complementary to a known sequence in a target nucleic acid as required by independent claims 1 and 16 (see page 9). This argument was not persuasive, because Lockhart teaches oligonucleotide capture probes that are immobilized on a solid support and complementary to a known sequence of a target nucleic acid (see, for example, page 9, line 21 - page 10, line 2, page 12, lines 3-15, page 20, lines 1-13, page 45, lines 7-30, and page 53, lines 21-30). Although

Lockhart teaches at page 71 that different embodiments of the disclosed methods include the use of oligonucleotide probes that can be randomly selected, haphazardly selected, composition biased, inclusive of all possible oligonucleotides of a particular length, *etc*, the disclosed methods are not limited to these embodiments.

Applicant also argues that the labeled probes used in the method of Lockhart must include a ligatable oligonucleotide and a ligase (see page 9). Applicant argues that this feature of the methods of Lockhart requires the free oligonucleotide probe to hybridize to the second portion of the target sequence at a position close enough to permit ligation and that the fluorescent label is located at the 5' end of the ligatable oligonucleotide probe (see page 9). Applicant further argues that Lockhart does not recognize or discuss the importance of label placement in terms of its interaction with metallic particles on the substrate (see page 9).

These arguments were not persuasive, because the importance of the label position relative to metallic particles on the substrate is taught in the Gryczynski reference. As discussed above, an ordinary artisan would have been motivated by the teachings of Gryczynski to sandwich the fluorescent label used in the detection methods of Lockhart between metal particles in order to enhance the observed signal. It is further noted that the claimed methods do not exclude methods, such as the methods resulting from the combined teachings of the cited references, in which the free probe is ligated to the capture probe. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is further noted that Lockhart expressly teaches that the position of the fluorescent label is not limited to

the 5' terminus so long as the labeled probe can undergo a ligation reaction (see, for example, page 10, lines 3-13 and also pages 40 and 42).

Applicant further argues that the Gryczynski reference (Lakowicz in Applicant's response) does not teach or suggest placement of the fluorophore on the free probe as required by the rejected claims (see pages 9-11). In particular, Applicant argues that the teachings of Gryczynski are directed to increasing the intrinsic fluorescence of nucleic acids rather than increasing the fluorescence of external fluorophores (pages 9-10). Applicant also argues that the only discussion in the reference pertaining to external fluorophores contains negative teachings that would lead the ordinary artisan away from sandwiching an external fluorophore, such as those disclosed by Lockhart (pages 9-10).

These arguments were not persuasive, because the teachings of Gryczynski cited by Applicant appear to discuss complications in one specific embodiment involving the use of fluorescently labeled nucleotides, specifically exonuclease-based sequencing. More specifically, Gryczynski teaches that a limiting factor in exonuclease-based sequencing is the need to label each nucleotide after exonuclease catalyzed release from the target nucleic acid (see page 10 of the response, where the teachings of Gryczynski are reproduced). These teachings of Gryczynski do not appear to consider detecting external fluorescent labels to be problematic, but rather attaching external fluorescent labels to sequentially released nucleotides to be problematic. Since the methods of Lockhart are not directed to exonuclease-based sequencing and do not require the complicated post-cleavage labeling step required by exonuclease-based sequencing methods, the teachings of Gryczynski would not have lead the ordinary artisan away from using metallic particles as disclosed in Gryczynski to increase the signal of the external fluorophores

covalently coupled to the disclosed free probes that are used in the methods disclosed by Lockhart. Attention is also directed to MPEP 2145 and 2123, which state that a "teaching away" requires an active discouragement or disparagement of the proposed solution. Finally, it is noted that the Gryczynski expressly suggests applying the disclosed methods of metal-induced fluorescence enhancement to nucleic acid hybridization assays conducted using external fluorescent labels (pages 102-103).

Applicant further argues that the Gryczynski reference does not teach or suggest positioning the fluorophore in the manner required by the rejected claims (page 10). This argument was not persuasive, because as discussed above Gryczynski provides explicit guidance (see page 98, for example), regarding the optimal distance between metallic particles and fluorophores that lead to enhancement of the properties of the fluorophore.

Applicant further argues that Lockhart only teaches the use of external fluorophores and does not teach detection of target nucleic acids based on intrinsic DNA fluorescence (pages 10-11). Applicant argues that the only method that could result from the combined teachings of Lockhart and Gryczynski is a method in which the intrinsic DNA fluorescence is used to detect target nucleic acids, and that such a method would render the methods of Lockhart unsuitable for the intended purpose (pages 10-11).

This argument was not persuasive, because as discussed above, the ordinary artisan would have been motivated by the teachings of Gryczynski to sandwich the external fluorophore contained in the free probe of Lockhart between metallic particles to enhance its signal. Doing so would not cause the method of Lockhart to depend on the detection of intrinsic DNA fluorescence and also would not render the method of Lockhart inoperable or unsuitable for its

intended purpose. Rather, application of the teachings of Gryczynski to the method of Lockhart would have improved the method by increasing its sensitivity and enhancing the signal obtained from the external fluorophore contained in the free probe.

It is further noted that the teachings of Gryczynski clearly indicate that metallic particles can be used to enhance the fluorescence properties of external fluorophores, such as rose bengal and rhodamine B (see Figures 3-4 on page 97). The teachings of Gryczynski also suggest suitable distances for placement of the fluorophore to maximize metal-induced enhancement of the fluorescence (page 98). It is noted that it would have been well within the capabilities of the ordinary artisan to apply these teachings of Gryczynski to the methods taught by Lockhart, since all that would be required is selection of a suitable external fluorophore and placement of the fluororphore at a suitable distance from the surface of the array. Since Gryczynski provided explicit guidance as to suitable external fluorophores and optimal metal-fluorophore distances, the ordinary artisan would have had a reasonable expectation of success in using metallic particles to enhance the fluorescence of the external fluorophores used in the methods disclosed by Lockhart. It is also noted that, in contrast to Applicant's arguments, the fluorophores are not required to be located at the terminus of the probes taught by Lockhart. Lockhart does not impose such a limitation on the probes, and the ordinary artisan would have recognized that the location of the fluorophore could be altered (e.g. to an internal position on the free probe of Lockhart), if necessary to provide a suitable distance between the fluorophore and metallic particles. The only requirement imposed on the probes by Lockhart is that they are able to undergo ligation (page 10, lines 3-13). Since the synthesis of oligonucleotide probes having internal fluorescent labels was routine in the art (see, for example, pages 40 and 42 of Lockhart),

an ordinary artisan would have had a reasonable expectation of success in modifying the position of the external fluorophore contained in the free probes of Lockhart if necessary to apply the teachings of Gryczynski to the utmost advantage.

Finally, Applicant argues that the teachings of Cao and Qi do not remedy the deficiencies of the Lockhart and Gryczynski references (see page 12). This argument was not persuasive, because these references are only relied upon to establish that the ordinary artisan would have had a reasonable expectation of success in attaching oligonucleotides to silver particles and to provide motivation for detecting *B. anthracis* nucleic acids, respectively.

Since Applicant's arguments were not persuasive, the rejection has been maintained.

Applicant's arguments filed on May 5, 2009 regarding the rejection of claims 1, 4-10, 12-16, and 18-27 under 35 U.S.C. 103(a) as being unpatentable over Cao as evidenced by Malicka and Lukomska in view of Lakowicz I and further in view of Lakowicz II have also been fully considered, but they were not persuasive. In view of the cancellation of claim 23, this rejection currently applies to claims 1, 4-10, 12-16, 18-22, and 24-27.

Applicant first argues that inclusion of the Malicka and Lukomska references in the rejection is improper, since these references are post-filing art (see page 12). This argument was not persuasive, because as discussed in the rejection, the Malicka and Lukomska references are only relied upon to establish inherent features present in the teachings of Cao. As noted in MPEP 2112 II, inherency need not be recognized prior to the filing date of the instant application. Therefore, inclusion of the evidentiary Malicka and Lukomska references in the rejection is not improper.

Applicant also argues that the declaration made under 37 CFR 1.131 is sufficient to

overcome the primary reference cited in the rejection (Cao), which was published on August 30, 2002 (see pages 12-13). This argument was not persuasive, because the declaration was insufficient to overcome the Cao reference. As discussed in greater detail above, the declaration does establish diligence from a date prior to the date of reduction to practice of the Cao reference to either a constructive reduction to practice or an actual reduction to practice.

Since Applicant's arguments were not persuasive, the rejection has been maintained.

Conclusion

10. No claims are currently allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela M. Bertagna whose telephone number is (571)272-8291. The examiner can normally be reached on M-F, 9- 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Horlick/
Primary Examiner, Art Unit 1637

/Angela M. Bertagna/
Examiner, Art Unit 1637